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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/611,575 | 07/01/2003 | John Holmes | MS1-1526US | 5173 |
| 22801 | 7590 | 06/20/2007 | EXAMINER | |
| LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201 | | | PATEL, HARESH N | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2154 | |
| | | | NOTIFICATION DATE | DELIVERY MODE |
| | | | 06/20/2007 | ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

lhptoms@leehayes.com

Office Action Summary

Application No.

10/611,575

Applicant(s)

HOLMES ET AL.

Examiner

Haresh Patel

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date See Continuation Sheet.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :7/1/03, 12/3/04, 2/25/05, 1/17/06, 9/18/06.

DETAILED ACTION

1. Claims 18-22 are subject to examination. Claims 1-17 are cancelled.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The present title, "Transport system for instant messaging" is too broad and not sufficient for proper classification of the claimed subject matter.

Drawings

3. The figures submitted on 7/1/03 are acknowledged and accepted.

Information Disclosure Statement

4. An initialed and dated copy of the applicant's IDS form 1449, paper dated 7/1/03, 12/3/04, 2/25/05, 1/17/06, 9/18/06, is attached to the instant Office action.

Claim Objections

5. Following claims are objected to because of the following informalities:

Claims 19-22 mentions, "A computer-readable medium", which should be --The computer-readable medium--

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claim 18 and its dependent claims are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps/elements/structural cooperative relationships of elements, such omission amounting to a gap between the steps/elements/necessary structural connections. See MPEP § 2172.01. The omitted steps/elements/necessary structural connections are: 1) **entities** between which peer-to-peer connection is established, 2) **missing step** coordinating establishing an instant messaging session step and automatically establishing a peer-to-peer connection step 3) **element that causes** establishing the peer-to-peer connection. The peer-to-peer connection by itself cannot exist and cannot be established. The peer-to-peer connection needs to coordinate with the establishing of the instant messaging session and without usage of element that causes the establishing, the peer-to-peer connection cannot happen randomly.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 18-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Dickerman et al. 2003/0177184 (Hereinafter Dickerman).

9. Referring to claim 18, Dickerman discloses a computer-readable medium having stored thereon computer-executable instructions for performing a method comprising: establishing an instant messaging session between a first client computer and a second client computer via a switchboard server (e.g., col., 1); automatically establishing a peer-to-peer connection (e.g., col., 1); transmitting first data associated with the instant messaging session via the switchboard server (e.g., col., 2); and transmitting second data associated with the instant messaging session via the peer-to-peer connection (e.g., col., 2).

10. Referring to claim 19, Dickerman discloses determining an active network device configuration associated with the first client computer and the second client computer (e.g., col., 7); and selecting a peer-to-peer bridge corresponding to the active network configuration (e.g., col., 8).

11. Referring to claim 20, Dickerman discloses wherein the peer-to-peer bridge comprises an RUDP bridge (e.g., col., 10).

12. Referring to claim 21, Dickerman discloses the peer-to-peer bridge comprises a TCP/IP bridge (e.g., col., 10).

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13. Referring to claim 22, Dickerman discloses transmitting a first portion of a blob of the first data via the switchboard server (e.g., col., 7); and transmitting a subsequent portion of the blob of the first data via the peer-to-peer connection (e.g., col., 7).

Conclusion


Examiner has cited particular columns and line numbers and/or paragraphs and/or sections and/or page numbers in the reference(s) as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety, as potentially teaching, all or part of the claimed invention, as well as the context of the passage, as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haresh Patel whose telephone number is (571) 272-3973. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 10:00 am to 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn, can be reached at (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 Haresh Patel

Haresh Patel

June 5, 2007